

PRE-APPEAL BRIEF REQUEST FOR REVIEW transmitted by EFS		Docket Number (Optional) 1103326-0584						
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>9 December 2010</u></p> <p>Signature <u>/John M. Genova/</u></p> <p>Typed or printed name <u>John M. Genova</u></p>	<table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="width: 50%; padding: 5px;">Application Number 09/380,519</td><td style="width: 50%; padding: 5px;">Filed 3 September 1999</td></tr><tr><td colspan="2" style="padding: 5px;">First Named Inventor Petri Horppu</td></tr><tr><td style="padding: 5px;">Art Unit 3731</td><td style="padding: 5px;">Examiner Mcevoy, Thomas M.</td></tr></table>		Application Number 09/380,519	Filed 3 September 1999	First Named Inventor Petri Horppu		Art Unit 3731	Examiner Mcevoy, Thomas M.
Application Number 09/380,519	Filed 3 September 1999							
First Named Inventor Petri Horppu								
Art Unit 3731	Examiner Mcevoy, Thomas M.							
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,224</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top;"><p><u>/John M. Genova/</u> Signature</p><p><u>John M. Genova</u> Typed or printed name</p><p><u>212-819-8832</u> Telephone number</p><p><u>9 December 2010</u> Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,224</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p><u>/John M. Genova/</u> Signature</p> <p><u>John M. Genova</u> Typed or printed name</p> <p><u>212-819-8832</u> Telephone number</p> <p><u>9 December 2010</u> Date</p>				
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<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>								

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Petri Horppu et al.
Serial No. : 09/380,519
Filing or 371(c) date : 3 September 1999
For : Mounting Apparatus
Examiner : Mcevoy, Thomas
Group Art Unit : 3731

CERTIFICATE OF EFS-WEB TRANSMISSION	
I hereby certify that this paper is being transmitted via the Electronic Filing System to the U.S. Patent and Trademark Office on the date indicated below.	
<u>/John M. Genova/</u>	<u>32,224</u>
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<u>John M. Genova</u>	<u>9 December 2010</u>
Signer's Name	Date

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**REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicants request review of the rejection in the final Office Action mailed 17 June 2010 in the referenced application. Submitted concurrently herewith are:

1. Notice of Appeal (Form PTO/SB/31), and
2. Applicant's Pre-Appeal Brief Request for Review (Form PTO/SB/33).

The Commissioner is authorized to charge the Notice of Appeal fee of \$540.00 under 37 C.F.R. §41.20(b)(1) to Deposit Account No. 23-1703.

REMARKS

Applicants respectfully submit that the Examiner has made a factual error by incorrectly interpreting and applying the cited prior art in support of the obviousness rejection of record based on a combination of references.

1. The claimed invention

The claimed mounting apparatus comprises:

- (1) a tapered adapter having a plurality of circumferentially spaced-apart fingers extending from the rear larger end towards the forward smaller end of the adapter (See Figs. 5-8), and
- (2) an expander device movable relative to the adapter and having a circumference and a plurality of circumferentially spaced-apart arms insertable between the fingers of the adaptor, wherein the thickness of the arms of the expander device taper in a radial direction towards the center of the circumference (See Figs. 9-15) .

As described in specification and as illustrated by the Figures, the expressly recited structure of the tapered adaptor and expander device permits these components to cooperate or mesh with each other in such a way as to impart certain operational advantages to the claimed invention. Specifically, with reference to Figures 9-12, the expander device **24** of the claimed invention has spaced apart arms **26** mounted at their rear ends to the circumference of the forward end of a tube **28**. As the arms **26** converge from the circumference of the tube **28**, the forward ends **30** taper, i.e., diminish or decrease in range, in a radial direction toward the center. The purpose of this structure is to facilitate the mating and slidable engagement of the spaced-apart arms **26** of the expander device **24** between the fingers **22** of the adaptor **14**.

2. Prosecution history

Claims 1-2, 5-9 and 15-18 are pending. Claims 17-18 are withdrawn from consideration in view of the restriction requirement of record.

Claims 1, 2, 5-9, 15 and 16 are rejected under 35 U.S.C. §103(b) as being unpatentable over US 4,548,201 to Yoon (“Yoon”) in view of US 5,643,290 to Clark et

al. (“Clark”).

3. Argument: Factual Error

On page 3 of the final Office Action, the Examiner acknowledges that the primary reference to Yoon fails to disclose an expander device (**Fig. 21A**) having arms that are insertable between the fingers of the adaptor (**100, 101**). For this purpose, the Examiner relies on the secondary reference to Clark and states that Clark teaches that it is advantageous to insert arms of an expander device between fingers of an adaptor to provide better alignment and loading of a cord. In this regard, the Examiner cites Clark at column 2, lines 42-44, and the Abstract. In conclusion, the Examiner alleges that it would have obvious in view of Clark to have made the arms of the Yoon expander device (**Fig. 21A**) insertable between fingers of the adaptor **100, 101** in order to better align the adaptor and expander and to provide an even pushing force on the cord.

Applicants respectfully disagree and submit that the modification to Yoon as proposed by the Examiner would defeat the intended purpose and function of Yoon.

Specifically, the Examiner relies on expander device (**Fig. 21A**) which is disclosed by Yoon at column 12, lines 37-39, as a suitable substitute for ring dilator **130** (See Fig. 18) and ring dilator **131** (See Fig. 20). Yoon requires that each of ring dilators **130** and **131** “rotate tangentially” to allow the central aperture **134** to expand and adapt to the increasing cross-sectional area of the conic surfaces **102, 103** of ring loaders **100, 101**. The required “rotate tangentially” feature with respect to ring dilators **130** and **131** is disclosed at column 11, lines 52-58, and column 12, lines 29-36, respectively. Accordingly, it is an express purpose of Yoon to provide for unimpeded rotation of the dilator during engagement with the loader.

If Yoon describes ring dilator of **Fig. 21A** as suitable for the claimed invention, then Applicants submit that ring dilator of **Fig. 21A** must also be capable of tangential rotation just as ring dilators **130** and **131** are capable of tangential rotation. Tangential rotation of the ring dilator is an expressly required feature and function of Yoon. If the ring dilator of **Fig. 21A** were to be modified as proposed by the Examiner to have arms that are insertable between the fingers of the ring loader, then it is quite clear that tangential rotation of ring dilator **Fig. 21A** would be prevented in noncompliance with the express requirements of Yoon.

For all of the foregoing reasons, modification of Yoon to provide for keyed alignment, or an inter-lockable combination between the ring dilator and ring loader as stated by the Examiner on page 5 of the final Office Action, is antithetical to Yoon. Any such inter-lockable combination would prevent tangential rotation of the ring dilator relative to the ring loader.

Even after *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), it remains the law that the prior art cannot be modified to meet the claimed invention if the modification would render the prior art unsatisfactory for its intended purpose. In this regard, the Examiners' attention is directed to the guidance provided by lines provided by M.P.E.P §2143.01:

M.P.E.P §2143.01 "Suggestion or Motivation To Modify the References [R-6] - 2100 Patentability"

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

4. Conclusion

Applicants respectfully submit that the Examiner has made a factual error by incorrectly interpreting and applying the cited prior art in support of the obviousness rejection of record. The structural modifications proposed the Examiner to meet the claimed invention would render the primary reference to Yoon unsatisfactory for its intended purpose. As such, a *prima facie* case of obviousness has not been established.

Claims 1, 2, 5-9, 15 and 16 are directed to patentable subject matter. Applicants request withdrawal of the rejection and the issuance of a Notice of Allowance.

Authorization is hereby given to charge any fee due in connection with this communication to Deposit Account No. 23-1703.

Dated: 9 December 2010

Respectfully submitted,

/John M. Genova/

John M. Genova

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